UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,999	05/04/2001	Gerald W. Ingram	023460-00007	7592

24256	7590	11/06/2003

DINSMORE & SHOHL, LLP
1900 CHEMED CENTER
255 EAST FIFTH STREET
CINCINNATI, OH 45202

EXAMINER
PHAM, KHANH B

ART UNIT	PAPER NUMBER
2177	

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/847,999	INGRAM ET AL.
	Examiner	Art Unit
	Khanh B. Pham	2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 September 2003* .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-33* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

  If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____ .

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

  a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Response to Amendment

1.   The amendment filed 9/19/2003 has been entered.

- The title has been amended.

- The specification has been amended.

- Claims 1-25 have been canceled.

- Claims 26-33 have been added.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

4.   **Claims 26-27 and 30 are rejected under 35 U.S.C. 103(a)** as being

unpatentable over Newfield et al. ("Scratchpad: Mechanisms for Better Navigation in

Directed Web Searching"), hereinafter "**Newfield**", and in view of Gennaro et al. (US

5,742,768 A), hereinafter "**Gennaro**".

   As per claim 26, Newfield teaches a method of operating a computer,

comprising:

- "providing a visual display; displaying digital content in a first window on the
  visual display, the digital content including a hyperlink" at page 6, Fig. 2;

- "providing a graphical interface on the visual display that is operative to
  effectuate a designation of a hyperlink" at page 6, Fig. 2;

- "visually generating a plurality of individually selectable user options on the
  visual display, including at least one option for performing the non-linking
  functionality of automatically copying the hyperlink to a temporary,
  session-based second window in a manner that permits the copied hyperlink to
  be independently activated and processed" at page 5, Col. 1, 2nd paragraph and
  Fig. 1;

- "selecting the displayed individually selectable user option of copying the
  hyperlink to the temporary, session-based second window and automatically
  performing such non-linking functionality of automatically copying the hyperlink

to the temporary, session-based second window in response to the selection" at

page 5, Col. 1, 2nd paragraph and Fig. 1.

Newfield does not teach: "visually generating a plurality of individually selectable

user options on the visual display in response to a positioning of a pointer at or near the

hyperlink". However, Gennaro teaches a similar method for navigating hyperlink,

including the steps of: "visually generating a plurality of individually selectable user

options on the visual display in response to a positioning of a pointer at or near the

hyperlink" at Col. 2 lines 48-53 and Figs. 2A-B. Thus, it would have been obvious to one

of ordinary skill in the art at the time of invention to combine Newfield and Gennaro's

teaching to display available options to user "in response to a positioning of a pointer at

or near the hyperlink" without requiring user to click on the hyperlink, in order to "provide

an easier and more efficient way to access information form that web page" (Gennaro,

Col. 2 lines 45-50).

As per claim 27, Newfield and Gennaro teach the method of claim 26 as

discussed above. Newfield also teaches: "multiple hyperlinks are copied to the

temporary, session-based second window and wherein each of the copied hyperlinks

can be independently activated and processed" at page 5, Col. 1, 2nd paragraph and

Fig. 1.

As per claim 30, Newfield teaches a method of operating a computer,

comprising:

• "providing a visual display; displaying digital content in a first window on the visual

display, the digital content including a hyperlink" at page 6, Fig. 2;

- "providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink" at page 6, Fig. 2;

  - "visually generating a plurality of individually selectable user options on the visual display, including at least one option for performing the non-linking functionality of automatically creating a hyperlink for the displayed digital content, copying the created hyperlink for the displayed digital content to a viewable list in a temporary, session-based second window, and loading the digital content associated with the designated hyperlink in the first window on the visual display" at page 5, Col. 1, 2nd paragraph and Fig. 1;

  - "selecting the displayed individually selectable user option of automatically creating a hyperlink for the displayed digital content, copying the created hyperlink for the displayed digital content to a viewable list in the temporary, session-based second window" at page 5, Col. 1, 2nd paragraph and Fig. 1;

  - "loading the digital content associated with the designated hyperlink in the first window on the visual display and performing such non-linking functionality in response to the selection" page 5, Col. 1, 3rd paragraph.

Newfield does not teach: "visually generating a plurality of individually selectable user options on the visual display in response to a positioning of a pointer at or near the hyperlink". However, Gennaro teaches a similar method for navigating hyperlink, including the steps of: "visually generating a plurality of individually selectable user options on the visual display in response to a positioning of a pointer at or near the hyperlink" at Col. 2 lines 48-53 and Figs. 2A-B. Thus, it would have been obvious to one

of ordinary skill in the art at the time of invention to combine Newfield and Gennaro's

teaching to display available options to user "in response to a positioning of a pointer at

or near the hyperlink" without requiring user to click on the hyperlink, in order to "provide

an easier and more efficient way to access information form that web page" (Gennaro,

Col. 2 lines 45-50).

5.   **Claims 28-29, 31-33 are rejected under 35 U.S.C. 103(a)** as being

unpatentable over Newfield and Gennaro, as applied to claims 26-27, 30 above, and

further in view of Jain (US 2003/0030679 A1), hereinafter referred to as "Jain".

As per claim 28, Newfield and Gennaro teach the method of claim 26 as

discussed above. Newfield and Gennaro do not teach "the non-linking functionality

further comprises copying any associated graphical elements embedded in the

hyperlink to the second window" However, Jain teaches a similar method for copying

hyperlink to bookmark windows (see Abstract), including the step of: "copying any

associated graphical element embedded in the hyperlink to the second window" at Col.

2, [0022]. Thus, it would have been obvious to one of ordinary skill in the art at the time

of invention was made to modified Newfield and Gennaro's teaching in view of Jain

such that the graphical element associated with the hyperlink is copied to the second

window in order to make it easier for user to recognize the hyperlink by viewing its

associated graphical image.

As per claim 29, Newfield, Gennaro and Jain teach the method of claim 28 as discussed above. Jain also teaches: "the associated graphical element comprises a graphical image embedded in the hyperlink" at Col. 2, [0022].

As per claim 31, Newfield teaches a method of operating a computer, comprising:

- "providing a visual display; displaying digital content in a first window on the visual display, the digital content including a hyperlink" at page 6, Fig. 2;

- "providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink" at page 6, Fig. 2;

- "visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink, including at least one option for performing the non-linking functionality of automatically copying the hyperlink to a second window in a manner that permits the copied hyperlink to be independently activated and processed" at page 5, Col. 1, 2nd paragraph and Fig. 1;

- "selecting the individually selectable user option of copying the hyperlink to a second window and automatically performing such non-linking functionality of automatically copying the hyperlink to a second window in response to the selection" at page 5, Col. 1, 2nd paragraph and Fig. 1;

Newfield does not teach: "visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink" nor ". However, Gennaro teaches a similar method for navigating hyperlink, including the

steps of: "visually generating a plurality of individually selectable user options on the visual display in to the designation of the hyperlink" at Col. 2 lines 48-53 and Figs. 2A-B.

Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Newfield and Gennaro's teaching to display available options to user "in response to a positioning of a pointer at or near the hyperlink" without requiring user to click on the hyperlink, in order to "provide an easier and more efficient way to access information form that web page" (Gennaro, Col. 2 lines 45-50).

Newfield and Gennaro do not teach: "the non-linking functionality further comprises copying any associated graphical elements corresponding to the hyperlink to the second window, and further wherein the associated graphical element comprises a graphical image embedded in the hyperlink".

However, Jain teaches a similar method for copying hyperlink to bookmark window (see Abstract), including the step of: "copying any associated graphical element embedded in the hyperlink to the second window" at Col. 2, [0022]. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modified Newfield and Gennaro's teaching in view of Jain such that the graphical element associated with the hyperlink is copied to the second window in order to make it easier for user to recognize the hyperlink by viewing its associated graphical image.

As per claim 32, Newfield, Gennaro and Jain teach the method of claim 31 as discussed above. Gennaro also teaches: "the designation of a hyperlink comprises positioning a pointer at or near the hyperlink" at Col. 2 lines 45-55.

As per claim 33, Newfield, Gennaro and Jain teach the method of claim 31 as

discussed above. Newfield also teaches: "the second window comprises a temporary,

session-based window" at page 5, Col. 1, 2nd paragraph.

Double Patenting

6.   A rejection based on double patenting of the "same invention" type finds its
support in the language of 35 U.S.C. 101 which states that "whoever invents or
discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis
added). Thus, the term "same invention," in this context, means an invention drawn to
identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re
Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164
USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by
canceling or amending the conflicting claims so they are no longer coextensive in
scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection
based upon 35 U.S.C. 101.

7.   **Claims 26-33 are provisionally rejected under 35 U.S.C. 101** as claiming the

same invention as that of claims 174, 175, 176 of copending Application No.

09/594,786. This is a <u>provisional</u> double patenting rejection since the conflicting claims

have not in fact been patented.

Claim 175 of the copending application No. 09/594,786 recites the limitation of

claims 26, 31-33, as follows:

- "providing a visual display; displaying digital content in a first window on the

  visual display, the digital content including a hyperlink" (claim 173, lines 2-4);

- "providing a graphical interface on the visual display that is operative to

  effectuate a designation of a hyperlink" (claim 173, lines 5-6);

- "visually generating a plurality of individually selectable user options on the visual

display in response to a positioning of a pointer at or near the hyperlink, including at

least one option for performing the non-linking functionality of automatically copying the

hyperlink to a temporary, session-based second window in a manner that permits the

copied hyperlink to be independently activated and processed" (Claim 173, lines 7-11);

- "selecting the displayed individually selectable user option of copying the hyperlink

  to the temporary, session-based second window and automatically performing such

  non-linking functionality of automatically copying the hyperlink to the temporary,

  session-based second window in response to the selection" (Claims 173, lines 12-

  14)

Claim 174 of the copending application No. 09/594,786 recites the limitation of

claims 27 and 31 as follows:

"wherein multiple hyperlinks are copied to the temporary, session-based second

window and wherein each of the copied hyperlinks can be independently activated and

processed" (Claim 174, lines 1-3.)

Claim 175 of the copending application No. 09/594,786 recites the limitation of

claims 28-29 and 31 as follows:

"wherein the non-linking functionality further comprises copying any associated

graphical elements embedded in the hyperlink to the second window" (Claims 175, lines

1-3.)

Claim 176 of the copending application No. 09/594,786 recites the limitation of

claim 30 as follows:

- "providing a visual display; displaying digital content in a first window on the visual display, the digital content including a hyperlink" (claim 176, lines 2-4);

- "providing a graphical interface on the visual display that is operative to effectuate a designation of a hyperlink" (Claim 176, lines 5-6);

- "visually generating a plurality of individually selectable user options on the visual display in response to the designation of the hyperlink, including at least one option for performing the non-linking functionality of automatically creating a hyperlink for the displayed digital content, copying the created hyperlink for the displayed digital content to a viewable list in a temporary, session-based second window, and loading the digital content associated with the designated hyperlink in the first window on the visual display" (Claims 176, lines 7-12);

- "selecting the displayed individually selectable user option of automatically creating a hyperlink for the displayed digital content, copying the created hyperlink for the displayed digital content to a viewable list in the temporary, session-based second window; loading the digital content associated with the designated hyperlink in the first window on the visual display and performing such non-linking functionality in response to the selection" (Claims 176, lines 13-17).

Response to Arguments

8.   Applicant's arguments with respect to claims 26-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (703) 308-7299. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703)746-

7240.

Khanh B. Pham
Examiner
Art Unit 2177

KBP
October 28, 2003

JEAN R. HOMERE
PRIMARY EXAMINER